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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/701,634	12/01/2000	Makoto Miyazawa	Q61929	8039

7590 05/12/2003

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EXAMINER	
MARKHAM, WESLEY D	

14

ART UNIT	PAPER NUMBER
1762	

DATE MAILED: 05/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/701,634	MIYAZAWA, MAKOTO	
	Examin r	Art Unit	
	Wesley D Markham	1762	

--The MAILING DATE of this communication app ars on th cover sheet with the correspondenc address --

THE REPLY FILED 14 April 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

   (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *see attached Office Action*.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☐ The a)☐ affidavit, b)☐ exhibit, or c)☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☒ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *1-5 and 11-14*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☒ Other: *see attached Office Action*

WDM

DETAILED ACTION / ADVISORY ACTION

Response to Amendment

1. Acknowledgement is made of applicant's proposed amendment D, filed as paper #18 on 4/14/2003, in which the applicant proposed to amend independent Claim 1 and Claim 14 and to cancel Claims 5 and 13. However, this amendment has not been entered because it raises issues that would require further searching and/or consideration. Specifically, the applicant's proposed amendment to independent Claim 1 would further require (1) that the edging mark be positioned outside the first region of a surface of the spectacle lens, and (2) an edging step of cutting the spectacle lens into the shape of the inner peripheral edge of openings of the spectacle frame to remove the second region. Entry of these limitations into independent Claim 1 would change the scope of the claim and would also change the scope of the claims depending from Claim 1. Further, the applicant's proposed amendment to Claim 14 (i.e., to depend the claim from Claim 1 as opposed to Claim 13) would change the scope of Claim 14. As such, entry of the applicant's proposed amendment would require further searching and/or consideration, and therefore the amendment has not been entered.

Response to Arguments

2. The applicant's arguments filed on 4/14/2003 have been fully considered but are not persuasive.

3. The applicant argues that the applied references fail to teach or suggest the edging mark of the marking step claimed in Claim 1. Specifically, the applicant states that the edging outline taught by Logan et al. is a cutting line, and following the edging outline, the lens blank is immediately cut off. The applicant reasons that it would not have been obvious to one of ordinary skill in the art to use the edging outline for a use other than as a cutting line, such as a "boundary for appearance inspection". The applicant then states that, unlike Logan et al., the edging mark of the present invention is not a cutting line; rather, the edging mark indicates a first region of the lens remaining after edging and functions as a "boundary for appearance inspection".
4. In response and as a preliminary matter, please note that one cannot show non-obviousness by attacking references individually (i.e., Logan et al. individually) where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Additionally, the examiner notes that the limitation that the edging mark or line "functions as a boundary for appearance inspection" is not explicitly taught by the combination of references involving Logan et al. However, Logan et al. teach that the optical industry generally produces a pattern having the size and shape of a lens opening in an eyeglass frame for use as a guide in an edge grinding and contouring apparatus to peripherally edge grind the optical lens to the size and shape of the lens opening. The shape of the lens opening is transferred to the surface of the lens blank by tracing the outline of the inner periphery of the lens

opening with a marker. The blank is then cut following the outline on the blank surface to form a pattern corresponding to the associated traced lens opening (Col.1, lines 15 – 30). In other words, the edging outline taught by Logan et al. "functions as a boundary" between the portion of the lens blank which forms the lens and the portion of the lens blank that is cut-off. Since the lens is cut following the outline of the blank surface, it would have been obvious to one of ordinary skill in the art to look at (i.e., inspect) the edging line in order to insure that the lens is cut to the appropriate size and shape (i.e., by following the edging outline) as desired by Logan et al. As such, the edging line of Logan et al. "functions as a boundary for appearance inspection" as required by the applicant's claims. In the alternative, the combination of Kato, Logan et al., Wood et al., and either Blomberg et al. or the AAPA teaches all the process steps and limitations of the applicant's claims, including marking an edging line on the surface of a spectacle lens, the edging line corresponding to spectacle frame openings. Although the prior art references do not explicitly teach that the edging line "functions as a boundary for appearance inspection", the edging line itself which is reasonably suggested by the prior art is equivalent to the applicant's claimed edging line. Therefore, the edging line of the prior art inherently functions as a "boundary for appearance inspection" as required by the applicant's claims. The applicant has not shown that the edging mark / line recited in the claims differs from the edging line reasonably suggested by the prior art in any manner except for intended use (i.e., that the claimed line functions as a boundary for appearance inspection). Please note that a recitation of the intended

use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure (i.e., the edging line) is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Importantly, please note that the applicant's claims only require that the edging line function as a boundary for appearance inspection; no actual "appearance inspection" step (i.e., in which only the area inside the edging line is inspected) is required by the applicant's claims. As such, there is no structural difference between the edging line reasonably suggested by the prior art and the edging line claimed by the applicant, nor is there a manipulative difference between the process reasonably suggested by the prior art and the process steps presently claimed by the applicant.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wesley D Markham whose telephone number is (703) 308-7557. The examiner can normally be reached on Monday - Friday, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (703) 308-2333. The fax phone numbers

for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Wesley D Markham
Examiner
Art Unit 1762

WDM
May 7, 2003

SHRIVE P. BECK
SUPERVISORY PATENT EXAMINER
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